<u>REMARKS</u>

In the Office Action mailed from the United States Patent and Trademark Office on April

21, 2008, claims 28, 29, and 33 were rejected under 35 U.S.C. § 112, second paragraph, as being

indefinite, claims 12-17, 20-21, 24-29, 33, and 35-49 were rejected under 35 U.S.C. § 103(a) as

being unpatentable over U.S. Patent No. 6,498,656 to Mastie et al. (hereinafter "Mastie") in view

of U.S. Patent Application Publication No. 2002/0001495 to Mochizuki (hereinafter

"Mochizuki") in further view of U.S. Patent No. 5,684,931 to Hagar (hereinafter "Hagar"), and

claim 34 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Mastie in view of

Mochizuki and Hagar in further view of U.S. Patent Application Publication No. 2003/0160993

to Kang (hereinafter "Kang"). Applicant therefore respectfully provides the following:

Claim 28 is amended herein.

<u>Rejections under 35 U.S.C. § 112, Second Paragraph</u>:

In the Office Action, claims 28, 29, and 33 were rejected as being indefinite. Applicant

has amended claim 28 to address the issue raised in the Office Action and requests removal of

the rejections.

<u>Rejections under 35 U.S.C. § 103</u>:

In the Office Action, all claims were rejected under 35 U.S.C. § 103(a) as being

unpatentable over combinations of references including Mastie, Mochizuki, and Hagar.

M.P.E.P. § 2141 sets forth the *Graham* factual enquiries that should be considered when making

an obviousness rejection under Section 103: 1) ascertaining the scope and content of the prior

art; 2) ascertaining the differences between the claimed invention and the prior art; and 3)

resolving the level of ordinary skill in the pertinent art. (Citing *Graham v. John Deere*, 383 U.S.

1, 148 USPQ 459 (1966).) In addition, M.P.E.P. §§ 2141 and 2142 set forth that "the analysis

supporting a rejection under 35 U.S.C. 103 should be made explicit." (Citing *KSR International*

Co. v. Teleflex Inc. (KSR), 550 U.S. ___, 82 USPQ2d 1385 (2007).)

Therefore, for a rejection under Section 103 to stand, it must explicitly set forth 1) factual

findings showing that each claim element was known in the art at the time of the invention, and

2) factual findings showing that one of ordinary skill in the art, at the time of the invention,

would have found it obvious to modify or combine the teachings to arrive at the claimed

invention. (See, for example, the enumerated required articulations set forth in M.P.E.P. § 2143

for each lettered rationale.) The Court in *KSR International* expressly instructed that "a patent

composed of several elements is not proved obvious merely by demonstrating that each of its

elements was, independently, known in the prior art." *Id.* at 1396; *See* M.P.E.P. 2143. "In

determining the differences between the prior art and the claims, the question under 35 U.S.C.

103 is not whether the differences <u>themselves</u> would have been obvious, but whether the claimed

invention <u>as a whole</u> would have been obvious." M.P.E.P. § 2141.02 (emphasis in original).

Applicant respectfully submits that the references in the Office Action, either alone or in

combination, do not teach or suggest all the limitations claimed in the claim set provided herein.

Applicant also respectfully submits that the Office Action has failed to show how one of skill in

the art would have found it obvious to overcome the differences between the prior art and the

claimed invention to arrive at the claimed invention.

<u>Addition of Hagar to the Rejections:</u>

It is noted that the addition of Hagar was made in the Office Action to show a printer

with a processor, memory, input device, output device, and display. An indication was made that

one of ordinary skill in the art would have been able to modify the teachings of Mastie and

Mochizuki to use a computer instead of a printer "since the printer has all the functions of a computer." (See Office Action at page 6, first and second paragraphs, which is the only mention of Hagar.) Applicant notes that Hagar is otherwise irrelevant to the claimed invention, as Hagar does not disclose any management of print jobs across a network of computers and printing devices. Hagar merely discloses a label printer that includes some components commonly associated with some client computers (processor, memory, etc.). (Abstract, Fig. 2) Applicant also contests the proposition that one of skill in the art would have found it obvious from the disclosure of Hagar to use a computer instead of a printer.

Specifically, nothing in Hagar indicates that a printer has all the functions of a computer. While Hagar teaches a printer that includes named elements that might be found on a computer, Hagar fails to disclose anywhere that the disclosed printer "has all the functions of a computer." In fact, an appropriate reading of Hagar clearly shows that the printer of Hagar does not have all the functions of a computer. For example, not once does Hagar mention any software, computer programs, applications, or other features commonly utilized by a computer to perform its functions. Therefore, Hagar fails to stand for the proposition relied upon by the rejections, and is also irrelevant to the features of the claims.

Citations in the Rejections and References to Claim Language in the Rejections:

Applicant notes the request in the Office Action that Applicant consider references in their entirety, and Applicant has done so. Applicant also notes that the Office Action generally includes references to particular portions of the cited references. However, Applicant notes that at least some of the references do not exist in the cited references. Applicant specifically notes multiple references to "Fig. 5" of Mastie. (See the Office Action at page 3.) Mastie does not include a Figure 5. (See Col. 3 lines 47-49)

Applicant also notes that portions of the rejections fail to properly express the claim limitations being rejected. For example, claim 18 recites, "sending the print job from the first client computer to the printing device <u>only after an event selected from the following events occurs</u>" (with recitation of several specific events). This specific language is not properly addressed in the rejections. Instead, the rejection misquotes this claim limitation thus, "sending the print job from the first client computer . . . to the printing device <u>after an event</u>," and alleges that the misquoted language is taught by Mastie. Specifically, the misquotation recited in the Office Action permits sending the print job after <u>any</u> event to be improperly read on the claim language actually set forth.

This is the exact problem to be avoided in examination by strictly adhering to the requirement that a claimed invention be considered "as a whole." (See M.P.E.P. § 2141.02.I.)

Applicant therefore respectfully requests that more attention to the specific teachings of the cited references be made and that more attention to the requirements imposed by the claim limitations taken as a whole be given.

<u>Failure of the Cited References to Teach All Claim Limitations:</u>

Independent claim 12 recites: "sending the print job from the first client computer to the printing device only after an event selected from the following events occurs: receiving no response to the broadcast intent at the first client computer; and receiving a response to the broadcast intent at the first client computer from at least one of the plurality of the client computers, followed by receiving a permission to send the print job to the printing device at the first client computer from the at least one of the plurality of the client computers." Such limitations are not taught by the cited references, either alone or in combination.

Applicant respectfully notes that the Office Action sets forth that Mastie fails to teach (as related to claim 12 – the limitations related to claims 28 and 40 will be addressed below):

receiving no response at the first client computer; and

receiving a response at the first client computer from at least one of the plurality of the client computers, followed by receiving a permission to send the print job to the printing device at the first client computer from the at least one of the plurality of the client computers;

Applicant also respectfully submits that Mastie fails to teach the claim limitation of:

sending the print job from the first client computer to the printing device only after an event selected from the following events occurs:

as the Office Action has already noted that Mastie fails to teach the recited events of receiving no response and receiving a response followed by a permission. Mastie therefore cannot teach sending the print job <u>only after an event</u> selected from events admittedly not taught by Mastie.

Applicant respectfully admits that Mastie teaches sending a print job to the printing device, but that is not the limitation recited in claim 12. As discussed above, each claim limitation cannot be considered in a vacuum independently of the other limitations. Therefore, the proper limitation that should be considered and that is not taught by Mastie is:

sending the print job from the first client computer to the printing device only after an event selected from the following events occurs:
receiving no response at the first client computer; and
receiving a response at the first client computer from at least one of the plurality of the client computers, followed by receiving a permission to send the print job to the printing device at the first client computer from the at least one of the plurality of the client computers;

Applicant also respectfully submits that Hagar fails to teach such limitations, for all the reasons discussed above in the section regarding the addition of Hagar as a reference in the recent Office Action. Therefore, if Mochizuki also fails to teach any of such limitations, then the combination of these three references also fails to teach any such limitations, for if <u>none</u> of the

cited references teach the recited claim elements, then a combination of the cited references also
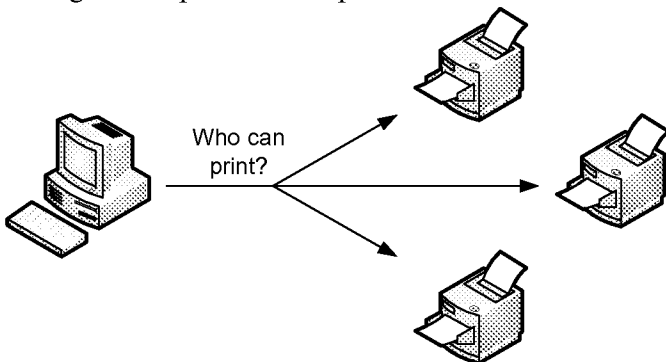
fails to teach the claim elements.

Mochizuki fails to teach the recited limitations that are not taught by Mastie or Hagar.

Mochizuki teaches a system that automatically selects a print-enabled printer for printing,

without the requester being conscious of the actual printer being selected. (Para. 0002) This is

done by a series of broadcast and unicast communications between the printing host and the

printers, as set forth in paragraphs 0041-0043, and as described in more detail below. The

process begins when the user prints a document. At this point, the host sends a broadcast

"printer retrieval packet" to all devices connected to the network. (Para. 0041, approximately ⅓

down in the paragraph) The printer retrieval packet includes a printer retrieval request and host

communication information that identifies the host. (Para. 0041, approximately ½ down; Para.

0042) The various printers receive the printer retrieval packet and each printer determines

whether its emulation matches that specified in the retrieval packet and its current print status; if

the determination is made that the printer is in a printable state, it sends a unicast response packet

back to the host only. (Para. 0041, approximately ⅔ down; Para. 0042) The response packet

includes printer communication information identifying the printer. (Para. 0041, near the end)

Mochizuki teaches that multiple response packets may be received by the host from

multiple printers, and that the host chooses the one that responded first. (First third of Para.

0043) The host then sends another broadcast, this of a print request packet that identifies the

chosen printer using the printer communication information from that printer's response packet.

(Para 0043, approximately ⅓-½ down) All printers receive the print request packet, recognize

that it is a print request and compare the printer identifying information in the request to their

own identifying communication information. (Para. 0043, approximately ⅔ down) The printer
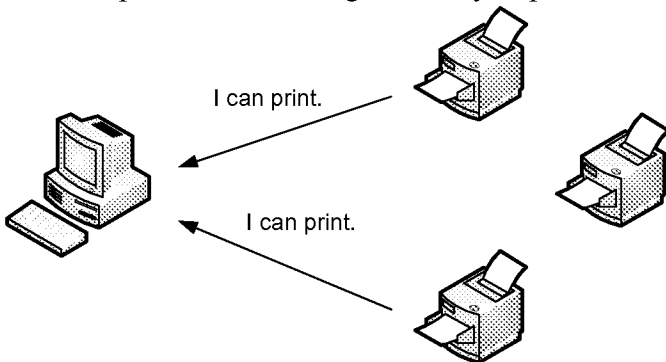
whose information matches that of the request then sends a response packet indicating that the

printer is ready for print processing. (Para. 0043, last third)

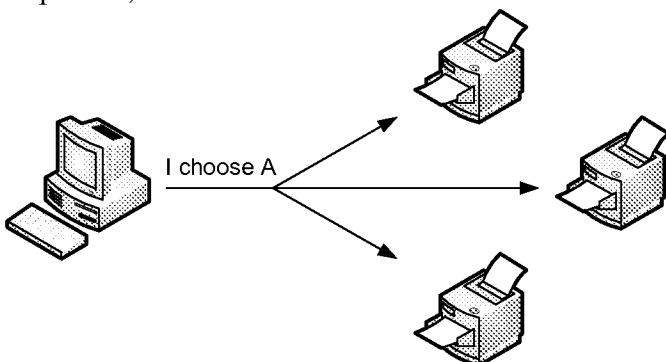Applicant has prepared the following graphics illustrating the processes of Mochizuki.

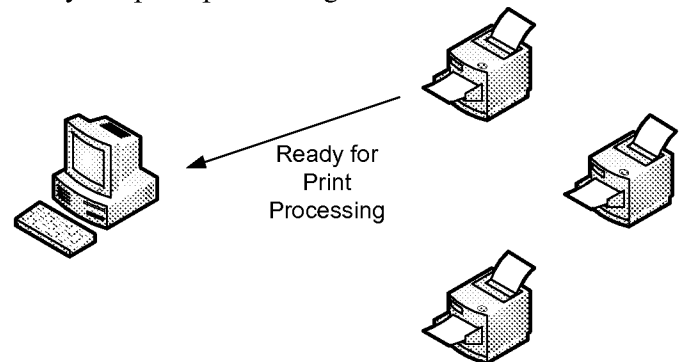1. At the first step, the host broadcasts a request asking which printers can print:

Who can print?

2. Next, the host receives one or more responses from the printers, indicating an ability to print:
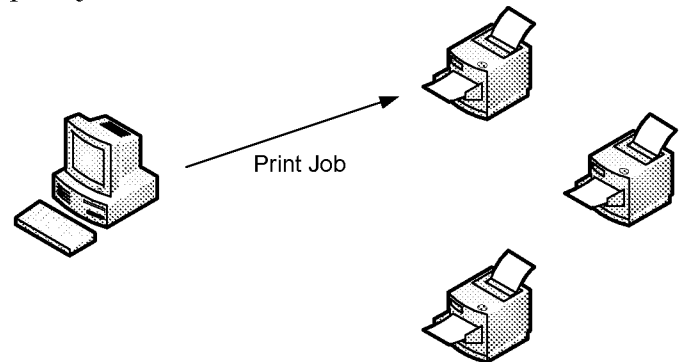
I can print.

I can print.

3. Then the host broadcasts its selection of which of the responding printers it picked (i.e. the first responder):

I choose A

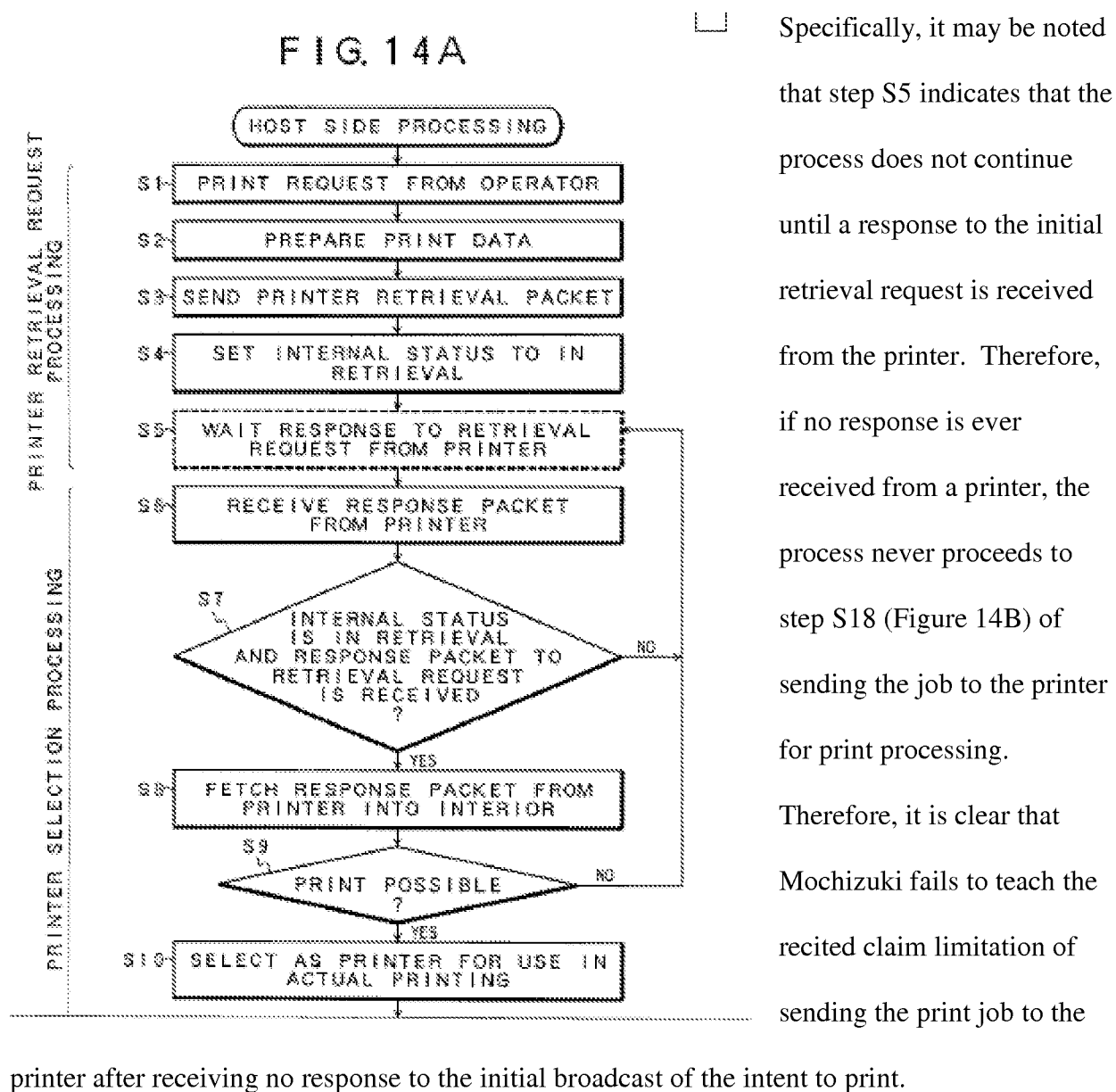4. And then, the selected printer responds that it is ready for print processing:

Ready for Print Processing

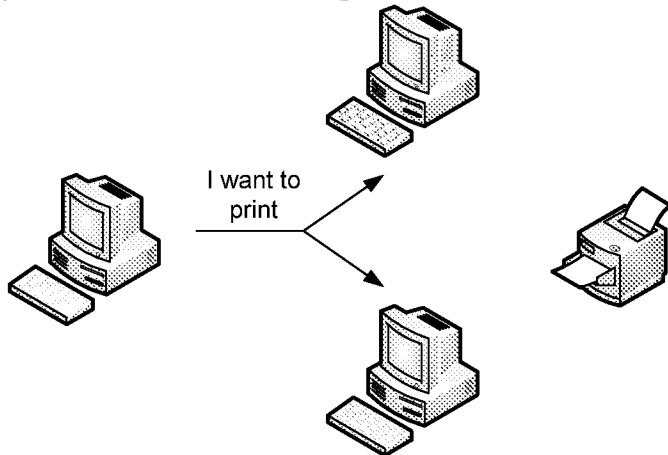5. After which the responding printer receives the print job:

Print Job

Applicant strongly contests that Mochizuki thus fails to teach the above-recited

limitations. First, applicant respectfully notes that Mochizuki fails to teach sending the print job

to a printer if no response is received to the initial broadcast intent to send the print job.

Specifically, reference may be made to Figure 14A of Mochizuki at step S5, as reproduced

below:

F I G. 1 4A

Specifically, it may be noted that step S5 indicates that the process does not continue until a response to the initial retrieval request is received from the printer. Therefore, if no response is ever received from a printer, the process never proceeds to step S18 (Figure 14B) of sending the job to the printer for print processing. Therefore, it is clear that Mochizuki fails to teach the recited claim limitation of sending the print job to the

printer after receiving no response to the initial broadcast of the intent to print.
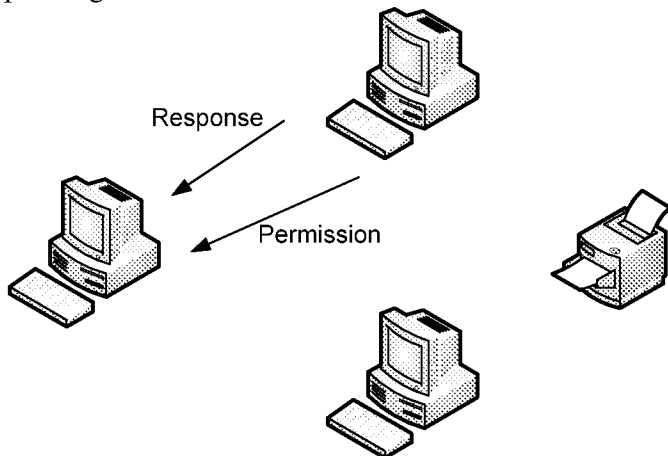
Similarly, Mochizuki fails to teach the other recited option for printing, that of sending

the print job only after receiving a response from the client computer device, followed by a

permission to print from the client computer device. For clarity, Applicant has prepared

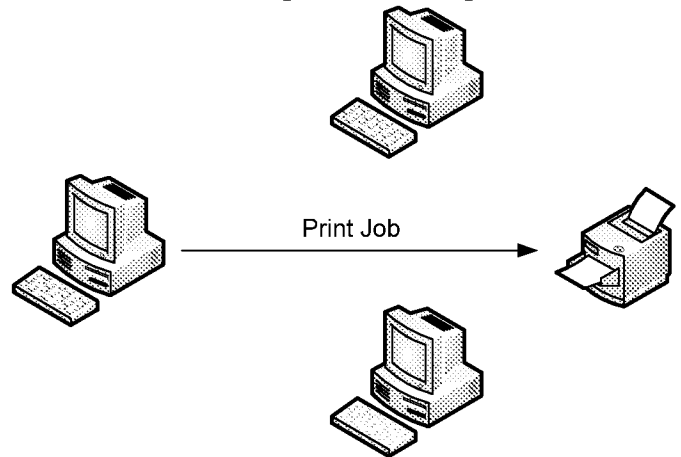illustrations showing how the claimed process functions:

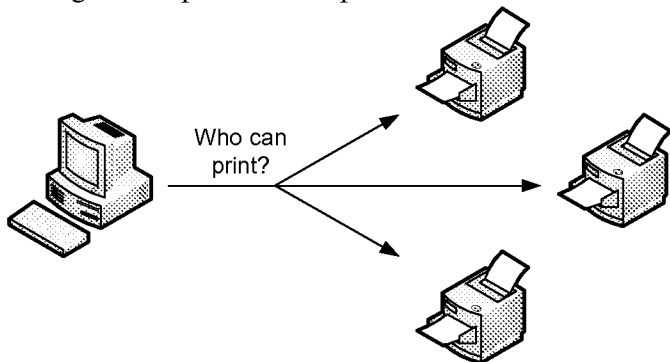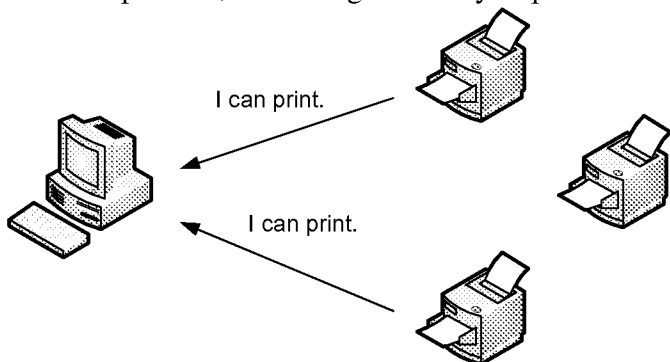| 1. First client broadcasts an intent to send the print job to the other client computers:	3. The first client then sends the print job to the printing device, which is not the same device from which it received the permission to print:
I want to print	Print Job
2. Next, the first client receives a response, followed by a permission to send the print job to the printing device: Response Permission	

Even assuming that one of skill in the art would find it obvious to replace the printers of

Mochizuki with computers (i.e. based solely on the disclosure of Hagar), which Applicant has

disputed above, it is clear from the foregoing diagrams that the system of Mochizuki fails to

function in the way recited in the claim. The rejections are based on a misinterpretation of

Mochizuki that would require that the Mochizuki system function in a way contrary to that

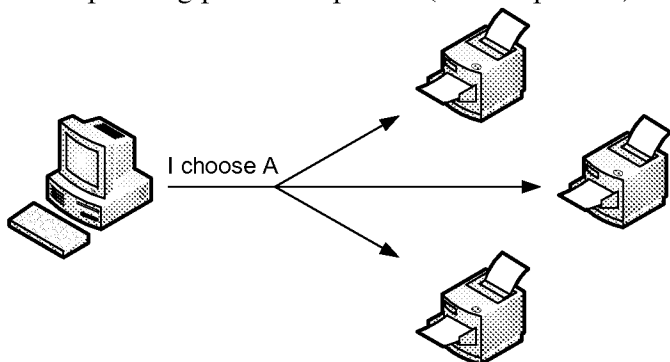disclosed, which function might be hypothetically illustrated as follows:

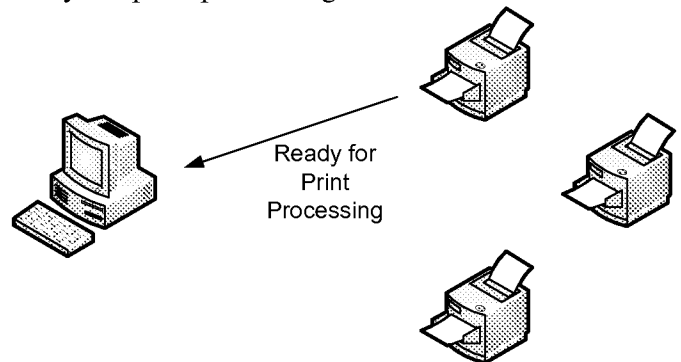1. At the first step, the host broadcasts a request asking which printers can print:

Who can print?

4. And then, the selected printer responds that it is ready for print processing:

Ready for Print Processing

2. Next, the host receives one or more responses from the printers, indicating an ability to print:

I can print.

I can print.

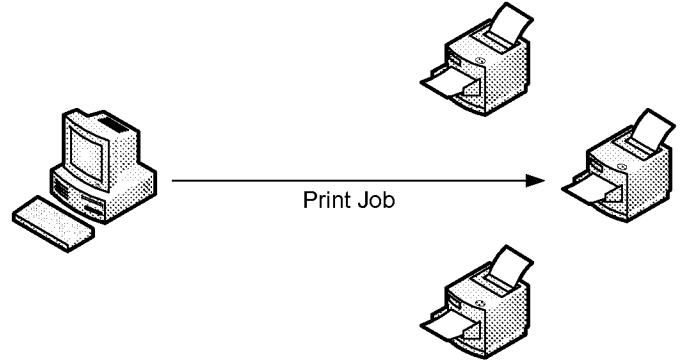5. After which the host sends the print job to some other printer rather than to the responding printer:

Print Job

3. Then the host broadcasts its selection of which of the responding printers it picked (first responder):

I choose A

From this illustration, it is clear that Mochizuki fails to teach such a system. In fact, this is clearly contrary to what Mochizuki teaches, as the printer that replies that it is ready to print the job would not receive the job. Instead, it would be send to some other printer. Therefore, Mochizuki fails to teach the limitations not taught by either Mastie or Hagar of:

> sending the print job from the first client computer to the printing device only after an event selected from the following events occurs:
>
>> receiving no response at the first client computer; and
>>
>> receiving a response at the first client computer from at least one of the plurality of the client computers, followed by receiving a permission to send the print job to the printing device at the first client computer from the at least one of the plurality of the client computers;

Therefore, Applicant respectfully submits that none of the cited references teach the recited claim elements, and that claim 1 is not made obvious.

Independent claim 28 contains similar limitations to those discussed above regarding claim 12. Claim 28 is also therefore not made obvious by the cited references. Claims 13-17, 20-21, 24-27, 29, 33, and 35-39 depend from one of claims 12 or claim 28 and are therefore similarly allowable.

Independent claim 40 contains similar limitations to those discussed above. Specifically, claim 40 recites:

> a response from a second client computer indicating that the second client computer is managing sending of print jobs to the printing device, wherein the response includes one of:
>
>> an indication that the second client computer has no objection to the first client computer sending the first print job to the printing device;
>>
>> an objection to and denial of the immediate sending of the first print job to the printing device by the first client computer; and
>>
>> an indication that a conflict must be resolved in order to permit the first client computer to send the first print job to the printing device.

Such limitations are not taught by the cited references for similar reasons to those discussed above.

Specifically, the Examiner has acknowledged that Mastie fails to teach these limitations. (See Office Action at paragraph spanning pages 3-4.) Mochizuki and Hagar also fail to teach these limitations. As discussed above, Hagar teaches nothing regarding management of print jobs on a network. The disclosure of Mochizuki is addressed in depth above; it is sufficient to note that although Mochizuki teaches receiving responses from the printers, the responses received are of one of two types: 1) a response indicating that the printer can print, and 2) a response indicating that the printer is ready for print processing. (See Para. 0041, last third-Para. 0042; Para. 0043, last third) Thus, neither of the two types of responses taught by Mochizuki is a "response . . . indicating that the second client computer is managing sending of print jobs to the printing device," as is required by claim 40. Even if one of skill in the art would find it obvious to substitute computers for printers based on the disclosure of Hagar, which Applicant has contested, the limitation is still not met, as neither of the responses taught would be a response from a computer indicating that it is managing sending of print jobs to a different printing device. Therefore, Mochizuki clearly does not teach the limitations that have been acknowledged are not taught by Mastie and that are not taught by Hagar.

As none of the cited references teaches the recited claim elements, the combination of references also fails to teach the claim elements. For at least these reasons, Applicant therefore respectfully submits that claim 40 is not made obvious by the cited combination of references. Claims 41-49 depend from claim 40 and are therefore similarly allowable for at least the same reasons.

Claim 34 was rejected as being unpatentable over Mastie in view of Mochizuki and Hagar in further view of Kang. Applicant respectfully submits that claim 34 is not made obvious by the cited references. Specifically, claim 34 depends from claim 12, and also includes the allowable limitations contained therein by dependency. Applicant respectfully submits that these limitations are not taught by Kang, or by the combination of the other cited references with Kang, and that therefore this claim is not made obvious by the cited combination. In the Office Action, Kang was relied on as teaching registering a client device for distributed management. This relied-upon teaching does not include teaching management of a print job using communications between client computers in the manner contained in the claims and discussed above, for all the reasons set forth in the last prior response, which is incorporated herein by reference.

Applicant respectfully submits, therefore, that the combination of Kang, Mastie, and Mochizuki fails to teach or suggest all claim limitations of the rejected claim 34, as is required for a *prima facie* case of obviousness. As the cited references fail to make obvious claim 34, Applicant respectfully requests removal of the rejection under 35 U.S.C. § 103(a).

Thus, Applicant respectfully submits that for at least the reasons provided herein, the claim set as provided herein overcomes all rejections made in the Office Action.

CONCLUSION

Applicant submits that the claims are in condition for allowance. Accordingly, Applicant requests favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

DATED this _21_ day of July, 2008.

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